

KIC 4947
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Claims 1, 19 and 24 are amended and claims 26, 27, 42 and 43 are canceled herein. Claims 1-25, 28-41 and 44-55 will be pending upon entry of the amendment.

RESPONSE TO REJECTION OF CLAIMS UNDER 35 USC §112,
AS FAILING TO COMPLY WITH THE ENABLEMENT REQUIREMENT

Reconsideration of the rejection of claims 1-55 under 35 USC §112, first paragraph as failing to comply with the enablement requirement is respectfully requested.

The Office action fails to set forth a prima facie case of lack of enablement. Specifically, at page 2 of the Office action, form paragraph 7.31.02 is used. See MPEP 706.03(c). However, the Office action clearly recognizes that the claims are enabled by the present application. Rather, the Office's position is actually that the specification does not enable an invention commensurate in scope with the claims, i.e., the claims are broader than what is enabled by the present application.

Such a position is more appropriately made by the Office using form paragraph 7.31.03, which deals with rejections relating to the scope of enablement. MPEP 706.03(c). To make a prima facie case regarding the scope of enablement, the Office must 1) identify the claimed subject matter for which the specification is enabled; 2) identify aspects of claim for which the specification is not enabling; and 3) identify the claimed subject matter for which the specification is not enabling. In addition, the Office must explain why the specification is not enabling, applying the factors set forth in *In re Wands*.

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The Office action does not provide any of the above evidence/arguments. Rather, the Office action merely lumps all of the claims together and states that all of the claims are broader than what the specification enables because they cover all products having the recited characteristics or properties. This is a conclusory statement unsupported by any evidence. Moreover, a number of the claims positively recite more structure than others. For example, dependent claims 17-20, which depend from claim 1, recite additional structure that is not positively recited in claim 1. However, the Office action does not explain why the additional structure recited in these claims is still non-enabled as being broader than what the specification enables. Applicants also note that on page 3 of the Office action the Office particularly recognizes claims 2-4, 9-21, 24, 26-29, 31-36 and 41-51 as being clearly defined, supported and disclosed. Thus, the Office's lack of enablement argument with respect to at least these claims is unclear.

Applicants also submit that all of the claims are sufficiently enabled commensurate with their scope. In particular, each of the independent claims includes the recitation of an absorbent structure sized and configured for insertion at least partially within the vestibule of the female wearer. Thus, applicants positively recite that the structure having the claimed performance characteristics must be 1) absorbent and 2) sized and configured for insertion at least partially within the vestibule of the female wearer. Thus, contrary to the Office's position, the claim does not cover all products that have the recited performance characteristics. Rather, only absorbent structures that are absorbent and are sized and configured as recited in the claims.

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Moreover, no undue experimentation is necessary to practice the full scope of the claims. In particular, the manner in which each of the tests recited in the claims is to be conducted is specifically set forth in the present specification. See *In re Wands*, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988). Thus, based on the present specification, one skilled in the art could readily make an absorbent structure that is absorbent, is sized and configured for insertion at least partially within the vestibule of the female wearer, and meets the recited performance characteristics. See also *Spectra-Physics Inc. v. Coherent Inc.*, 3 USPQ2d 1737, 1743 ("If an invention pertains to an art where the results are predictable, e.g., mechanical as opposed to chemical arts, a broad claim can be enabled by disclosure of a single embodiment.").

Because the claims are sufficiently enabled by at least one embodiment disclosed in the specification, claim 1 is submitted to satisfy the enablement requirement of 35 USC §112, first paragraph. To provide further structure to claim 1 of the present application, claim 1 is amended herein to further recite that the absorbent structure is constructed at least in part of hydrophilic fibers and superabsorbent material. Applicants submit claim 1 is further sufficiently enabled in view of such an amendment.

RESPONSE TO REJECTION OF CLAIMS
UNDER 35 USC §112, SECOND PARAGRAPH

Reconsideration of the rejection of claims 1-55 under the second paragraph of 35 USC §112 as being indefinite for failing to particularly point out and distinctly claim the subject

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matter which applicant regards as the invention is also requested.

The Office fails to make a prima facie case under 35 USC §112, second paragraph. In particular, at page 3 of the Office action the Office fails to provide any statement or evidence as to why any one of the claims, let alone each and every one of the claims, fails to 1) set forth the subject matter that applicants regard as their invention; and 2) particularly point out and distinctly define the metes and bounds of the subject matter that will be protected by the patent grant. See MPEP §2171.

According to MPEP §2172(I.), a rejection based on the failure to set forth the subject matter that applicants regard as their invention is appropriate only where applicant has stated, somewhere other than in the application as filed, that the invention is something different from what is defined by the claims. Thus, such a rejection is inappropriate in this case.

With respect to particularly pointing out and distinctly claiming the invention (see MPEP §2173 and 2174), applicants emphasize that the requirements of the first and second paragraphs of 35 USC §112 are separate and distinct. In particular, an assertion that the claims do not meet the enablement requirements of the first paragraph does not alone render the claim imprecise or indefinite or otherwise not in compliance with 35 USC §112, second paragraph. *Id.* Moreover, the breadth of the claim is not to be equated with indefiniteness. See MPEP §2173.04, citing *In re Miller*, 169 USPQ 597 (CCPA 1971).

The only guidance provided by the Office action as to the basis for the §112, second paragraph rejection is the statement

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that the claims lack clarity because "applicants attempt to define the product by reference to a result to be achieved." However, applicants submit that the invention may be defined in the claims using whatever terms applicants choose so long as any special meaning assigned to a term is set forth in the specification. See MPEP §2173.01, citing *In re Swinehart*, 439 F.2d 210, 160 USPQ 226 (CCPA 1971) (holding that a claim may not be rejected solely because of the type of language used to define the subject matter for which patent protection is sought).

Moreover, applicants note that the claims do not recite a desired result to be achieved, but rather they recite certain measurable characteristics of the absorbent structure being claimed. These are no different than claiming, e.g., a basis weight, a density, a length, etc. The fact that a particular test must be performed to determine whether the absorbent structure has the recited characteristic does not render such a characteristic indefinite. Indeed, the particular tests recited in the present claims are each well defined in the specification.

For the above reasons, claims 1-55 are submitted to satisfy the requirements of 35 USC §112, second paragraph.

RESPONSE TO REJECTION OF CLAIMS UNDER 35 USC §103

Claim 1

Claim 1 as amended herein is directed to an absorbent article for disposition at least partially within the vestibule of a female wearer. The absorbent article comprises an absorbent structure sized and configured for insertion at least partially within the vestibule of the female wearer. The absorbent structure is constructed at least in part of

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hydrophilic fibers and superabsorbent material and has 1) a saturation capacity as determined by a Saturation Capacity and Retention Capacity Test of at least about 15 grams/gram, 2) a retention capacity as determined by the Saturation Capacity and Retention Capacity Test of at least about 3 grams/gram, and 3) an intake time for a first insult of the absorbent structure as determined by an Intake and Rewet Test of no more than about 30 seconds.

The essence of claim 1 is the construction of the absorbent structure for disposition at least partially within the vestibule of a female wearer and to have the recited combination of saturation capacity, retention capacity and intake time. As discussed at paragraph [0061], in the past, absorbent articles could deliver either a good fluid intake rate or provide for an acceptable fluid capacity, but not both. The absorbent structure recited in claim 1, however, is capable of achieving both good saturation and retention capacity and a good fluid intake rate. In one example, the particular superabsorbent material used to construct the absorbent structure provides the absorbent structure with the combination of good fluid capacity and good intake rate.

Claim 1 is submitted to be non-obvious in view of and patentable over the references of record, and in particular US 2003/091442 (Bewick-Sonntag et al., referenced further herein as Bewick), in that whether considered alone or in combination the references fail to disclose or otherwise suggest an absorbent article comprised of an absorbent structure that is sized and configured for insertion at least partially within the vestibule of the female wearer, is constructed at least in part of hydrophilic fibers and superabsorbent material, and has

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the recited combination of saturation capacity, retention capacity and intake time.

Bewick discloses an absorbent device having a topsheet for contacting hydrous body tissues. In particular, as illustrated in Figs. 4 and 5, the absorbent device is an interlabial pad 20 composed of three key elements: 1) a highly adaptable absorbent structure able to macroscopically adapt to a unique anatomical shape, 2) a microscopically structured absorbent core/topsheet, and 3) a robust application/insertion design feature. See paragraphs [0016 - 0019]. With particular reference paragraphs [0110 - 0122], the absorbent core 44 is positioned between a topsheet 42 and back sheet 38 and provides the means for absorbing exudates such as menses.

According to Bewick, the absorbent core 44 in one embodiment is a fibrous batt, such as of rayon or a rayon/cotton blend. Paragraph [0113]. In other embodiments, the absorbent core 44 can comprise fibrous superabsorbent material in a concentration in the range of 25% to 100% and in particularly preferred embodiments a concentration above 70%. Paragraph [0114]. In one particular example, the superabsorbent fiber is FIBERDRI type 1162 superabsorbent fibers from Camelot Technologies Ltd. Of Alberta, Canada. Paragraphs [0119 and 0120]. In the working examples 2-5 described by Bewick, the absorbent core 44 comprised 50% of the FIBERDRI type 1162 superabsorbent fibers.

At paragraphs [0309 and 0310], Bewick describe an absorbent capacity test that is comparable to the retention capacity portion of the Saturation Capacity and Retention Capacity Test recited in claim 1 and described in the present application. Figure 23 of Bewick indicate that the absorbent capacity of the working Examples 2-5 of Bewick have an

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absorbent capacity of 7.3 grams/gram, which appears to meet the recited retention capacity of claim 1 of at least 3 grams/gram.

Bewick fails, however, to expressly disclose that the absorbent core 44 has an intake time for a first insult thereof of no more than about 30 seconds. Moreover, such a feature is not inherent in the absorbent core construction disclosed by Bewick. To establish inherency, the prior art "must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient."¹

There is nothing in the construction of the absorbent core 44 of Bewick that would necessarily result in the absorbent core having the intake time recited in claim 1. While it may even be possible, it is certainly not necessary and based on the disclosure of Bewick it is likely that the absorbent core of Bewick does not have the recited intake time. In particular, Bewick disclose superabsorbent concentrations of greater than 25%. As indicated in Fig. 12 of the present application, the intake time generally increases as the superabsorbent material concentration increases. In particular, codes 7 and 13 of Fig. 12 of the present application were constructed to have 25 percent superabsorbent concentration and as indicated these codes did not have the recited intake time even though they both met the recited saturation and retention capacities. Thus, it is clearly not a

¹ M.P.E.P. §2112 citing *In re Robertson*, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999).

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certainty that the absorbent core disclosed by Bewick will necessarily have the recited intake time even though it has the recited retention capacity.

The Office action takes the position that the recited retention capacity, saturation capacity and intake time recited in claim 1 are obvious because it is not inventive to discover the optimum or workable ranges by routine experimentation, citing *In re Aller*, 105 USPQ 233, 235 (CCPA 1955). As recognized by the Office, a particular parameter must first be recognized as a result-effective variable before the determination of the optimum or workable ranges of the parameter might be characterized as routine experimentation. MPEP §2144.05(II)(B), citing *In re Antonie*, 195 USPQ 6 (CCPA 1977).

In support of its optimization position, the Office action states that the benefits of optimizing saturation capacity and/or retention capacity, intake time and rewet (which is not recited in claim 1 but is recited in one or more dependent claims) "would have been known prior to applying a test, making these values result-effective variables." The Office's position appears to be similar to the very position rejected by the court in *In re Antonie*. In particular, the court noted that an assertion that it would always be obvious or ordinary skill in the art to try varying every parameter of a system in order to optimize the effectiveness of the system is improper "if there is no evidence in the record that the prior art recognized that particular parameter affected the result. *Id.* at 8 (emphasis added). Thus, the court made it clear that the recognition of a particular parameter as a result-effective variable must come from the cited reference, i.e., in this case Bewick.

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The Office action fails to provide any evidence as to how Bewick teaches the intake time (and rewet time, for that matter) are result-effective variables. Indeed, Bewick fails to indicate such a proposition.

For the above reasons, claim 1 is submitted to be non-obvious and patentable over the cited references.

Claims 2-23 depend directly or indirectly from claim 1 and are submitted to be non-obvious in view of and patentable over the references of record for the same reasons as claim 1. Claims 22 and 23 particularly recite a rewet of the recited absorbent structure. Bewick is silent as to the rewet of the absorbent core 44 thereof and clearly does not recognize rewet as a result-effective variable. For these additional reasons, claims 22 and 23 are further submitted to be patentable over the references of record.

Claim 24

Claim 24 as amended herein is directed to an absorbent article for disposition at least partially within the vestibule of a female wearer, said absorbent article comprising:

an absorbent structure sized and configured for insertion at least partially within the vestibule of the female wearer, said absorbent structure comprising in the range of about 5 weight percent to about 15 weight percent superabsorbent material, said absorbent structure having a basis weight in the range of about 150 to about 400 grams per square meter and a density in the range of about 0.05 to about 0.13 grams per cubic centimeter, said absorbent structure having a saturation capacity as determined by a Saturation Capacity and Retention Capacity Test of at least about 15 grams/gram and a retention

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capacity as determined by said Saturation Capacity and Retention Capacity Test of at least about 3 grams/gram.

The superabsorbent material concentration in the recited range provides for improved intake times during use of the absorbent article while still providing the recited saturation and retention capacities.

Claim 24 as amended is submitted to be non-obvious in view of and patentable over the references of record, and in particular Bewick, in that whether considered alone or in combination the references fail to disclose or suggest an absorbent article having an absorbent structure that is 1) sized and configured for insertion at least partially within the vestibule of the female wearer, 2) comprised of 5 to 15 weight percent superabsorbent material and 3) has the recited basis weight, density, retention capacity and saturation capacity.

In particular, as noted previously, Bewick disclose a superabsorbent fiber concentration in the range of 25-100 percent, and in a particularly preferred embodiment it is 70 percent. Thus, Bewick clearly fails to teach a superabsorbent material concentration in the range of 5-15 percent as recited in amended claim 24. Moreover, there is no suggestion found anywhere in Bewick for providing the superabsorbent fiber in a concentration of 5-15 percent.

For these reasons claim 24 as now presented is submitted to be patentable over the references of record.

Claims 25-40 depend directly or indirectly from claim 24 and are submitted to be patentable over the references of record for the same reasons as claim 24.

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Claim 41 is directed to an absorbent article for disposition at least partially within the vestibule of a female wearer. The absorbent articles comprises an absorbent structure sized and configured for insertion at least partially within the vestibule of the female wearer. The absorbent structure comprises in the range of about 5 weight percent to about 35 weight percent superabsorbent material, said absorbent structure having a basis weight in the range of about 150 to about 400 grams per square meter and a density in the range of about 0.05 to about 0.13 grams per cubic centimeter, said absorbent structure having an intake time for a first insult of said absorbent structure as determined by an Intake and Rewet Test of no more than about 30 seconds.

Claim 41 is submitted to be non-obvious in view of and patentable over the cited references and in particular Bewick, for substantially the same reasons as claim 1. In particular, Bewick neither expressly nor inherently discloses the recited intake time and also fails to provide any teaching that the intake time is a result-effective variable.

Claims 42-55 depend directly or indirectly from claim 41 and are submitted to be patentable over the references of record for the same reasons as claim 41.

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Conclusion

In view of the above, applicant respectfully requests favorable consideration and allowance of claims 1-25, 28-41 and 44-55 as now presented.

Respectfully submitted,



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